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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,957	11/18/2003	William H. Davis	032930-005	4586

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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/714,957

Applicant(s)

DAVIS, WILLIAM H.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) 8-32 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/23/2004  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-7, in the reply filed on April 28, 2005 is acknowledged. The traversal is on the grounds that the claims of additional groups could be conveniently prosecuted in the same application in spite of the different areas of classification. This is not found persuasive because the search of the additional groups would constitute a search burden as these groups have different classifications.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 28, 2005.

3. Claims 1-7 are under examination.

### ***Claim Rejections - 35 USC § 112, first paragraph - Enablement***

4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim is broadly drawn to wheat seeds "derived from the cross of 'WA7824' and 'Zeke' wheat varieties. Since the seed is essential to the claimed inventions, it must be obtainable by a repeatable method set forth in the specification or otherwise be

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readily available to the public. If the plant is not so obtainable or available, the requirements of 35 U.S.C. 112 may be satisfied by a deposit of the plant. The specification does not disclose a repeatable process to obtain the plant and it is not apparent if the plant is readily available to the public. Thus, a deposit is required for enablement purposes. A deposit of 2500 seed of each of the claimed embodiments is considered sufficient to ensure public availability. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strain has been deposited under the Budapest Treaty and that the strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement herein.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;

- (d) a test of the viability of the biological material at the time of deposit (see 37 C.F.R. 1.807) and,
- (e) the deposit will be replaced if it should ever become inviable.

Applicant's deposit statement in the pending application is not correct. The conditions for which the deposit will be made are not stated. There is no statement regarding the access of the invention to the Commissioner upon request, no statement regarding the removal of all restrictions upon granting of the patent, no statement regarding the duration the deposit will be maintained, no statement regarding the testing of the viability of the biological material at the time of the deposit, nor a statement regarding the replacement of the deposit if it should become inviable.

***Claim Rejections - 35 USC § 112, second paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims is broadly drawn to a process of selecting a wheat plant which exhibits genetically-controlled herbicide resistance that is not attributable to genetic engineering wherein in seeds used in said process are "derived" from the cross of two different wheat varieties. The term "derived" does no point out or distinctly claim the subject matter which Applicant regards as the inventions. Replacement of "derived" with

"produced" would overcome the rejection.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,339,184, January 15, 2002).

The claims are broadly drawn to a process for selecting a wheat plant which exhibits genetically-controlled herbicide resistance that is not attributable to genetic engineering comprising soaking mature wheat seeds in a liquid comprising glyphosate herbicide, planting said seeds following said soaking, and selecting wheat plants which exhibit genetically-controlled glyphosate herbicide resistance.

Smith teaches a method for selecting a wheat plant which exhibits genetically-controlled herbicide resistance that is not attributable to genetic engineering comprising soaking wheat seeds in a different herbicide solutions, planting said seed in a growing medium, namely soil, and selecting wheat plants that exhibit genetically-controlled herbicide resistance that is not attributable to a foreign gene introduced by genetic engineering (see column 8, line 30 to column 23, line 11 and column 24, lines 45-59).

Smith also teaches the spraying of plants that were selected as being resistance after the soaking step (see column 8, Example 1) and the soaking of seed for at least 6 hours (see column 10, lines 8-16). In addition, Smith teaches an aqueous solution in a concentration of approximately 1.5 to 6 percent by weight and approximately 2 percent by weight (see column 9, lines 19-22 and column 10, lines 8-16).

Smith does not teach the use of glyphosate as an herbicide.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Smith to produce a method for selecting a wheat plant which exhibits genetically-controlled herbicide resistance that is not attributable to genetic engineering.

One of ordinary skill in the art would have been motivated to modify the these teachings because the use of glyphosate herbicides that selectively eliminate weeds while leaving resistant crop plants undamaged is important in large scale commercial agriculture (see column 1, lines 33-37). In addition, one of ordinary skill in the art would have a reasonable expectation of success based on the success of Smith using AHAS inhibiting herbicide to develop wheat plants that exhibited genetically controlled glyphosate herbicide resistance that is not attributable to genetic engineering (see column 4, line 67).

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**Conclusion**

9. Claim 7 is free of the prior art given the failure of the prior art to teach or suggest use of a wheat seed derived from the cross of wheat varieties 'WA7824' and 'Zeke' in the claimed method.

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

June 30, 2005

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER

